

In claim 9, line 32, please delete the phrase "as defined in relation to formula (e) in claim 7" and replace it with the phrase "each independently hydrogen, halogen, substituted or unsubstituted alkyl or alkoxy".

REMARKS

Claims 1-13 are in this application. Claims 1-13 have been rejected.

Applicants respond to the Examiner's objections and rejections as follows.

I. Rejection under 35 U.S.C. § 112.

Claims 20, 31 and 33 have been rejected under 35 U.S.C § 112, first and second paragraphs. The Examiner suggests that: 1) the specification does not teach how to use the invention, because it fails support the scope of cardiovascular disease, 2) critical structural and hydrocarbyl limitations are not supported, and 3) claim 9 is a hybrid of compound and method. Applicants traverse this rejection.

Applicants have amended claim 1 and claim 9, so that claim 1 is directed only to a method of treating atherosclerosis, and now clearly recites various structural limitations upon the compounds useful in the method. The structural limitations expressed in claim 1 are now in accordance with the structural limitations recited in a grand parent to this application (U.S. Patent 5,002,953) which claimed the compounds per se. The treatment of atherosclerosis is disclosed in the application on page 20, line 37, and the structural limitations are disclosed in the application on page 2, lines 31-38, page 5, lines 1-5, page 6, lines 31-36, and page 7, lines 1-15. Thus, it is submitted that the scope of the disease treatable, and the compounds claimed in such treatment are clear, definite and supported.

Claim 9 is directed to a method of treatment, and is dependent upon claim 1 in both the disease state treated and the structural limitations imposed upon the compounds. That the limitations imposed by claim 1 are based both upon structure and utility is deemed proper. Thus, Applicants presume that the Examiner objects to the inclusion in the claim of a reference to a structural limitation from claim 7. Applicants have now amended claim 9 to incorporate the structural limitation of claim 7 verbatim. Accordingly, it is submitted that the claim incorporates all of the limitations only of claim 1, and is clear and definite.

In light of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C § 112.

II. Rejection for "Obviousness-type Double Patenting".

Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent 5,232,925, claim 1 of copending application Serial No. 457,387, and claims 1-12 of 457,154 (now Patent 5,521,201). The Examiner suggests that although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap. Applicants respectfully traverse these rejections.

At the outset, the Examiner will appreciate that the claims of the instant application have been amended. Accordingly, claims 1-13 of this application all relate to a method of treating atherosclerosis comprising administering a compound of the genus of formula (I), and the claims no longer relate to broader utility of treating cardiovascular. The cited references all relate to the treatment of a different disease state, or a different scope of compounds useful for treating the disease. Responding to each reference separately, Applicants point out the following:

a) U.S. Patent 5,232,925 ('925)

Claims 1-12 of the '925 patent relate to a method for treating hypertension. Since hypertension is a different disease, and can arise from various etiologies, the use of the compounds in a method for treating atherosclerosis is not rendered obvious by the use of similar compounds for the treatment of hypertension. Thus, favorable reconsideration of the rejection for obviousness-type double patenting is respectfully requested.

b) U.S. Serial No. 457,387 [now Patent 5,521,201] ('201)

Claim 1 of the '201 application is directed to the treatment of atherosclerosis by a single compound (5-[4-[2-[N-methyl-N-(2-pyridyl)amino]ethoxy]benzyl]thiazolidine-2,4-dione). The claims of the instant application are not directed to this compound but to a broad genus of compounds and certain specific compounds other than the compound claimed in the '201 patent. In fact the compound of claim 1 of the '201 patent was specifically deleted from claim 12 of the instant case by preliminary amendment.

Based merely upon the compound of the '201 patent, one skilled in the art would not recognize what structural modifications were permissible while still retaining activity in using the compounds for atherosclerosis. Since the structural variations described by the genera and species of the instant application would not be obvious in view of the single compound claimed in the '201 patent, it is submitted that the rejection for obviousness-type double patenting should be withdrawn.

Reconsideration and withdrawal of the rejection of claims 1-13 for obviousness-type double patenting is respectfully requested.

c) U.S. Serial No. 457,154

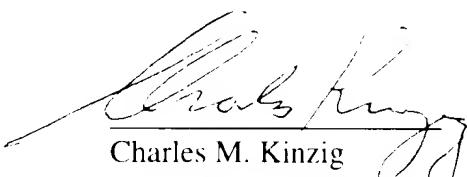
Claims 1-12 of the '154 application are directed to a method of treating "eating disorders." Eating disorders are a distinct medical problem from atherosclerosis. Eating disorders manifest themselves generally in the abnormal regulation of food intake, whereas, atherosclerosis is manifest, *inter alia*, by abnormal lipid levels and the thickening and narrowing of arteries. Consequently, one skilled in the art would not consider atherosclerosis to be an obvious variation of eating disorders.

Since the use of the compounds of this invention for the treatment of atherosclerosis is not an obvious variation of their use for eating disorders, favorable reconsideration of this rejection is respectfully requested.

III. Conclusion.

This response is intended to distinctly address each objection and rejection applied by the Examiner. Reconsideration of this application and allowance of all claims is respectfully requested. If any matters remain to be resolved before allowance, or discussion of any matter will facilitate the prosecution of this application, the Examiner is invited to call the undersigned agent at the number provided.

Respectfully submitted,



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